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October 17, 2002

Hon. James E. Rogan
Commissioner for Patents
Patent and Trademark Office
Washington, D.C. 20231

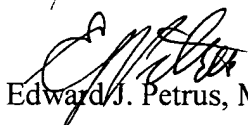
Re: 09/444,660 "Dietary supplement selector and method."

Dear Commissioner Rogan:

Enclosed is a petition regarding the finality of the Office Action and whether the Advisory Action complied with the Administrative Procedure Act.

In the alternative the petitioner submits a notice of appeal and a check for \$160 is enclosed.

Sincerely,


Edward J. Petrus, M.D.

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GROUP 3600

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:) Examiner: Rachel L. Porter
EDWARD J. PETRUS)

Serial No. 09/444,660) Group Art Unit: 2166

Filed: November 22, 1999)

For: DIETARY SUPPLEMENT SELECTOR AND METHOD

Assistant Commissioner for Patents
Washington, DC 20231

PETITION TO THE COMMISSIONER

The Petitioner requests a ruling by the Commissioner regarding the finality of the Office Action and whether the Advisory Action complied with the Administrative Procedure Act. In support of his position, the Petitioner offers the following chronology:

11/22/99 - Patent application filed

3/20/02 - First Office Action, rejecting claims 1-10.

6/11/02 - Response to the First Office sent retaining claims 1-5.

6/13/02 - Notified that a revised clean and marked up version requested.

6/24/02 - Clean and marked up version of the 6/11/02 response sent, no claims submitted.

9/11/02 - Final Office Action rejecting claims 1-5.

10/17/02 - Response to the Final Office Action, protesting the finality, and in the alternative requesting the response serve as an Amendment after Final Office action.

11/18/02 - Advisory Action continuing to reject claims 1-5.

1. The Office Action is not Final:

It is the belief of the Petitioner that the Final Action issued by the Examiner on September 11,

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2002, was not final. The Applicant filed amendments on June 11, 2002, to the Examiner's March 20, 2002, office action. On June 13, 2002, a request was made to place the 6/11/02 changes in a clean and marked up version. No new amendments were filed on June 24, 2002, as admitted by the Examiner (Advisory Action Pg 2, lines 11-12). Therefore, the Examiner's decision in the Final or
5 second Office Action that "[a]pplicants amendment necessitated new ground(s) of rejection presented in this Office Action" (Pg. 11, lines 12-13) is in error.

According to MPEP § 706.07(a), the Examiner can make the second or any subsequent actions on the merits final, "except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in
10 an information disclosure statement." In the first office action dated March 20, 2002, the Examiner rejected all claims under § 102 as being anticipated by Summerell. In the office action dated September 11, 2002, the Examiner withdrew the § 102 objection and changed the rejection to § 103 for the same claims. Now the same claims 1-5 were rejected under § 103 for obviousness as being unpatentable over Summerell, the original § 102 reference, and added a new reference, Riley.

15 If, as the examiner claims, the "[a]pplicant's arguments filed 6/24/02 have been fully considered but they are not persuasive" (Pg. 9, lines 14-15) then there is no basis for the examiner introducing a new ground of rejection, and the second office action filed 9/11/02 cannot be final. If the argument is not persuasive, and any amendments are cosmetic, then there is no basis for introducing a new ground for rejection. MPEP § 706.07(a) holds that "the examiner may NOT make
20 the next Office action relying on that art final unless all instances of the application of such art are necessitated by amendment." Since the examiner was not persuaded by the applicant's amended claims and remarks - there was no necessity to introduce a new ground of rejection.

MPEP § 706.07 states that “[b]efore final rejection is in order a clear issue should be developed between the examiner and applicant.” That has not happened in this case. No clear issue has been communicated to the applicant from the examiner. Also § 706.07 states that going “from one set of references to another by the examiner in rejecting in successive actions claims of substantially the same subject matter, will alike tend to defeat attaining the goal of reaching a clearly defined issue for an early termination, i.e., either an allowance of the application or a final rejection.” Applicant maintains that the subject matter is the same but the references and grounds for rejection introduced by the examiner are changing. Therefore, it is the Petitioner’s belief that the 9/11/02 office action was not final, but only the second office action in a three (3) year period of time.

In a prior § 1.181 petition, the Commissioner ruled that “the second Office action was improperly made Final and finality thereof is hereby withdrawn” when the objection was not raised in the First Office action and only introduced in the second office action, constituted a new ground of rejection not necessitated by applicant’s amendments. (Petition under 37 CFR § 1.181, filed May 31, 2001, Ser. No. 09/350,380, by Jasmine C. Chambers, July 17, 2001).

2. A rejection under § 103 for obviousness is without merit.

In the First Office Action, the Examiner filed a § 102 objection to the claims. In the second and final office action, the Examiner withdrew the § 102 rejection and replaced it with a § 103 rejection by adding another reference. Since a § 102 rejection for anticipation is established only when a single prior art reference discloses each and every element and limitation of the claims at issue, *Carella v. Starlight Archery and Pro Lines Co.*, 804 F.2d 135, 138 (Fed. Cir. 1986), and it was obvious to the examiner that Summerell could not withstand those requirements, a two-reference monte was created in the form of a § 103 rejection.

In a recent Court decision, *In re Lee*, 61 USPQ2d (Fed Cir. 2002), a copy of which is attached for your benefit, the Court vacated the Board's decision for failure to meet the adjudicative standards for review under the Administrative Procedure Act. Lee pressed the examiner during prosecution for some teaching, suggestion, or motivation in the prior art to select and combine references that were relied on to show obviousness. In Lee, the Court overturned the Board's decision "that a 'specific hint or suggestion' of motivation to combine was not required."

In the instant case, the Petitioner also pressed the examiner to explain the teaching, suggestion, or motivation in the prior art that was relied on to show obviousness, and maintained that a claim of obviousness based on Summerell and Riley could not be made (Pg. 8, lines 20-21). The Examiner argues that "there is no requirement that the motivation to make modifications must be expressly articulated within the references themselves." (Pg 5, lines 22-23, Pg. 6, lines 1-2). Lee teaches that the examiner must articulate the reasons for that decision.

Claims 1-5 were rejected under § 103(a) as being unpatentable over Summerell. Summerell does not teach or suggest a method for creating a dietary supplement profile as inferred by the examiner. (Pg. 5, lines 15-16). Summerell offers no computer-controlled feedback loop by which the consequences of an event send back data that in turn modify that event in the future. Summerell recommends the same amount of vitamin C, vitamin E and folate as in a one-size fits all vitamin tablet, provides no feedback to modify the amount of vitamins, and makes no reference to other vitamins, minerals, amino acids, enzymes or herbs. The Examiner admits that "it is unclear if the system/method of Summerell adjusts for differences between the individuals health information when compared to an optimal health profile then generates a dietary supplement profile suggested for an optimal health profile." (Pg. 6, lines 20-21, Pg. 7, lines 1-2). This admission by the examiner nullifies

any rejection for obviousness under § 103. The Court in *Jones v. Hardy*, 727 F.2d 1524, 1529 (Fed. Cir. 1984) held that in determining obviousness, one must consider the invention as a whole; small differences between the claims and the prior art can therefore give rise to patentability.

Summerell teaches a method to determine a user's current physiological age (Col. 1, lines 10-11, claim 1).. Physiological age is defined as the "calendar age of an average person of the same gender with a comparable risk stratification level." (Col. 11, lines 25-27). Summerell provide various wellness plan options (Col. 3, lines 18-41) suggested to improve one's physiological age (Col. 2, lines 60-65). Summerell uses the information from the health profile questionnaire "to determine the user's relative risk stratification level" (Col. 9, line 35-37). In Figure 5, the questionnaire asks "Do you usually wear a seat belt?" Such questions have no significance in determining a dietary supplement profile, but in determining risk and calculating survival rate.

Summerell teaches the recognition of high blood pressure as a risk factor, but offers no dietary supplement profile to counteract the risk. Summerrell recommends the use of exercise, stress reduction, salt restriction, weight loss, decrease alcohol consumption and anti-hypertensive medication (Fig. 24). No individual dietary supplement plan is taught or suggested in the recommendation. His wellness plan considers total and HDL cholesterol, but only recommends reducing dietary cholesterol, exercise and an alcoholic drink at night (Fig. 18, 20, 22, 23). The weight loss recommendation in Fig 24 offers no individual plan but suggests a 10% reduction in weight. If such a recommendation had any chance of success there would be no rampant obesity and no weight loss centers in this country.

In the Applicant's invention, the amount of dietary supplements are adjusted to reflect changes in an individual's needs. See page 3, lines 22 to page 4, line 11. Summerell offers no dietary

supplement profile listing the vitamins, minerals, amino acids, enzymes and herbs suggested for an optimal health profile.

Applicant's invention uses information created by a health questionnaire and the addition of information provided by a physical exam and laboratory studies to generate a computer-implemented dietary supplement profile and a list of commercially available products to obtain an optimal health profile. Summerrel offers no such dietary supplement profile of vitamins, minerals, amino acids, enzymes and herbs, but makes general recommendations to reduce risk factors to calculate a survival rate.

To qualify as a § 103 rejection, the examiner presents a new reference, Riley, which teaches a method of providing seven (7) multi-vitamin and mineral formulations, referred to as modules. These modules are described on Column 4, lines 44-67 and column 5, lines 1-21. "Module 1, the basic formula, is directed to the general public and consists of vitamins and minerals essential for the prevention of vitamin and mineral deficiency diseases." There is no mechanism in the invention to determine what vitamin or mineral deficiencies exist. "Module 2 is a Stress Formula." Module 3 consists of "specific doses of vitamin, minerals and other compounds." "Module 4 contains aspirin." "Module 5 is essentially Module 1 combined with about 20 mg of aspirin within the AM tablet." "Module 6 is also essentially Module 1, but combined with about 81 mg of aspirin with the AM tablet." "Module 7 which is the same as the low dose formulation in Module 3, but combined with about 81 mg of aspirin." How does one know which module to take?

Riley offers no system/method of determining what modules to take. Riley teaches away from the invention of the applicant. Riley teaches that "[t]he use of laboratory methods to assess nutritional status, which includes blood and tissue levels of vitamins and their effects (A, C, E, D, etc)

on various enzyme systems (B1, B2, B6), is often considered the most reliable method of assessing nutritional status, though these special testing procedures are expensive and do not exist in standard medical offices or in many hospital clinical laboratories (Col. 2, lines 42-49). Riley goes on to state that “certified nutrition assessments, the expenses involved, and the time required to conduct necessary history taking, physical examination and appropriate laboratory testing, it is apparent that consumers are forced into making their own nutrient supplement choices.” (Col. 2, lines 62-66). The health questionnaire, lab studies and physical exam used in the applicant’s invention are taught away by Riley. The Supreme Court held in *United States v. Adams*, 383 U.S. 39, 148 USPQ 497 (1966) that one important indicium of nonobviousness is “teaching away” from the claimed invention by the prior art, and that the prior art’s teaching away was held to prevent a purported § 103 rejection.

The attachment to the advisory action (Paper no. 10) cites *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988), a copy of which is supplied for your benefit, in support of the issue of obviousness. In *Fine* the Court held that the PTO had not established a prima facie case of obviousness. “The references applied by the Board and Examiner were improperly combined, using hindsight reconstruction, without evidence to support the combination and in the face of contrary teachings in the prior art.” One of the references (Eads) “diverge from and teach away from the invention at hand” as does the Riley reference in the instant application. The Court held that neither reference alone or in combination, suggested the claimed invention.

The Applicant’s claims differ from Summerell and Riley and a claim of obviousness cannot be made. The CCPA and the Federal Circuit has consistently held that when a § 103 rejection is based upon a modification of a reference that destroys the intent, purpose or function of the invention disclosed in the reference, such a proposed modification is not proper and the prima facie case of

obviousness can not be properly made. See *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Applicant therefore submits that the rejection for obviousness based on Summerell and Riley is not legally justified and is therefore improper.


Since Riley teaches away, that leaves Summerell standing alone. Can a sole reference be used in a § 103 rejection, or does the rejection convert to a § 102 rejection, which was previously withdrawn? Since the issue of rejection is not clear, how can the Petitioner file an appeal?

Conclusion

Based on all the above cited facts and issues raised, it is the Petitioner's belief that a Petition to the Commissioner under 37 CFR § 1.181 is appropriate. In the alternative, the Petitioner submits a notice of appeal, with a fee of \$160.00. Should the Commissioner agree that the Petition under 37 CFR § 1.181 is appropriate, that the check be deposited in the Petitioner's account.

It is therefore petitioned that relief be granted under 37 CFR § 1.181, that any final action regarding this application is premature, and that the rejection for obviousness be withdrawn.

Respectfully submitted,


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December 2, 2002

signs was not legally erroneous, and because we find that the Board's finding that Valu's guide rails are *de jure* functional is supported by substantial evidence, the Board's refusal to register Valu's guide rail designs is *affirmed*, and Rexnord's cross-appeal is dismissed as moot.

AFFIRMED

COSTS

No costs.

In re Lee

**U.S. Court of Appeals
Federal Circuit**

No. 00-1158

Decided January 18, 2002

PATENTS

[1] Practice and procedure in Patent and Trademark Office — Board of Patent Appeals and Interferences — In general (§ 110.1101)

Patentability/Validity — Obviousness — Combining references (§ 115.0905)

Patentability/Validity — Obviousness — Evidence of (§ 115.0906)

Rejection of patent application for obviousness under 35 U.S.C. § 103 must be based on evidence comprehended by language of that section, and search for and analysis of prior art includes evidence relevant to finding of whether there is teaching, motivation, or suggestion to select and combine references relied on as evidence of obviousness: factual inquiry whether to combine references must be thorough and searching, based on objective evidence of record, and Board of Patent Appeals and Interferences must explain reasons why one of ordinary skill in art would have been motivated to select references and to combine them to render claimed invention obvious.

[2] Patentability/Validity — Obviousness — Combining references (§ 115.0905)

JUDICIAL PRACTICE AND PROCEDURE

Procedure — Judicial review — Standard of review — Patents (§ 410.4607.09)

Board of Patent Appeals and Interferences improperly relied upon "common knowledge and common sense" of person of ordinary skill in art to find invention of patent application obvious over combination of two prior art references, since factual question of motivation to select and combine references is material to patentability, and could not be resolved on subjective belief and unknown authority, since deferential review of agency decisions under Administrative Procedure Act reinforces obligation of board to develop evidentiary basis for its findings, since board's rejection of need for any specific hint or suggestion in particular reference to support combination constituted omission of relevant factor required by precedent, and thus was both legal error and arbitrary agency action, since board's findings must extend to all material facts and be documented on record, and since "common knowledge and common sense" are not specialized knowledge and expertise of agency contemplated by APA, and may not be substituted for evidence, although they may be applied to analysis of evidence.

PATENTS

[3] Practice and procedure in Patent and Trademark Office — Board of Patent Appeals and Interferences — In general (§ 110.1101)

Patentability/Validity — Obviousness — Evidence of (§ 115.0906)

JUDICIAL PRACTICE AND PROCEDURE

Procedure — Judicial review — Standard of review — Patents (§ 410.4607.09)

Patent examiners and Board of Patent Appeals and Interferences, in relying on what they assert to be general knowledge to negate patentability on ground of obviousness, must articulate that knowledge and place it on record, since examiners and board are pre-

sumed to act from viewpoint of person of ordinary skill in art in finding relevant facts, assessing significance of prior art, and making ultimate determination of obviousness issue; failure to do so is not consistent with either effective administrative procedure or effective judicial review, and board cannot rely on conclusory statements when dealing with particular combinations of prior art and specific claims, but must set forth rationale on which it relies.

[4] Procedure — Court of Appeals for the Federal Circuit (§ 410.03)

Procedure — Judicial review — Standard of review — Patents (§ 410.4607.09)

U.S. Court of Appeals for the Federal Circuit will not consider proposed alternative grounds for affirming decision of Board of Patent Appeals and Interferences rejecting patent application for obviousness; since alternative grounds were made at oral argument and constitute post hoc rationalization for agency action, consideration of which would deprive aggrieved party of fair opportunity to support its position.

Appeal from the U.S. Patent and Trademark Office, Board of Patent Appeals and Interferences.

Patent application of Sang-Su Lee, serial no. 07/631,210, directed to method of automatically displaying functions of video display device and demonstrating how to select and adjust functions to facilitate user response. Applicant appeals from decision upholding rejection of all claims for obviousness, and from reaffirmation of that decision on reconsideration. Reversed and remanded.

Richard H. Siern and Robert E. Bushnell, Washington, D.C., for Sang Su Lee.

Sidney O. Johnson Jr., associate solicitor, John M. Whealan, solicitor, and Raymond T. Chen, Maximilian R. Peterson, and Mark Nagumo, associate solicitors, Arlington, Va., for Director of U.S. Patent and Trademark Office.

Before Newman, Clevenger, and Dyk, circuit judges.

Newman, J.

Sang-Su Lee appeals the decision of the Board of Patent Appeals and Interferences of

the United States Patent and Trademark Office, rejecting all of the claims of Lee's patent application Serial No. 07/631,210 entitled "Self-Diagnosis and Sequential-Display Method of Every Function."¹ We vacate the Board's decision for failure to meet the adjudicative standards for review under the Administrative Procedure Act, and remand for further proceedings.

The Prosecution Record

Mr. Lee's patent application is directed to a method of automatically displaying the functions of a video display device and demonstrating how to select and adjust the functions in order to facilitate response by the user. The display and demonstration are achieved using computer-managed electronics, including pulse-width modulation and auto-tuning pulses, in accordance with procedures described in the specification. Claim 10 is representative:

10. A method for automatically displaying functions of a video display device, comprising:

determining if a demonstration mode is selected;

if said demonstration mode is selected, automatically entering a picture adjustment mode having a picture menu screen displaying a list of a plurality of picture functions; and

automatically demonstrating selection and adjustment of individual ones of said plurality of picture functions.

The examiner rejected the claims on the ground of obviousness, citing the combination of two references: United States Patent No. 4,626,892 to Nortrup, and the Thunderchopper Helicopter Operations Handbook for a video game. The Nortrup reference describes a television set having a menu display by which the user can adjust various picture and audio functions; however, the Nortrup display does not include a demonstration of how to adjust the functions. The Thunderchopper Handbook describes the Thunderchopper game's video display as having a "demonstration mode" showing how to play the game; however, the Thunderchopper Handbook makes no mention of the adjustment of picture or audio functions. The examiner held that it

¹ *Ex parte Lee*, No. 1994-1989 (Bd. Pat. App. & Int. Aug. 30, 1994, on reconsideration Sept. 29, 1999).

The conclusion of obviousness may be made from common knowledge and common sense of a person of ordinary skill in the art without any specific hint or suggestion in a particular reference.

The Board did not explain the common knowledge and common sense" on which it relied for its conclusion that "the combined teachings of Nortrup and Thunder-

This appeal followed.

Judicial Review

Judicial Review

Tribunals of the PTO are governed by the Administrative Procedure Act, and their rulings receive the same judicial deference as do tribunals of other administrative agencies. *Dickinson v. Zurko*, 527 U.S. 150, 50 USPQ2d 1930 (1999). Thus on appeal we review a PTO Board's findings and conclusions in accordance with the following criteria:

U.S.C. § 706(2) The reviewing court

(2) hold unlawful and set aside agency actions, findings, and conclusions found to be—

(A) arbitrary, capricious, an abuse of discretion, or otherwise not in accordance with law;

- * *
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(E) unsupported by substantial evidence in a case subject to sections 556 and 557 of this title or otherwise reviewed on the record of an agency hearing provided by statute:

For judicial review to be meaningfully achieved within these strictures, the agency tribunal must present a full and reasoned explanation of its decision. The agency tribunal

would have been obvious to a person of ordinary skill to combine the teachings of these references to produce the Lee system.

Lee appealed to the Board, arguing that the Thunderchopper Handbook simply explained how to play the Thunderchopper game, and that the prior art provided no teaching or motivation or suggestion to combine this reference with Norrup, or that such combination would produce the Lee invention. The Board held that it was not necessary to present a source of a teaching, suggestion, or motivation to combine these references or their teachings. The Board stated:

The conclusion of obviousness may be made from common knowledge and common sense of a person of ordinary skill in the art without any specific hint or suggestion in a particular reference.

Board op. at 7. The Board did not explain the “common knowledge and common sense” on which it relied for its conclusion that “the combined teachings of Nortrup and Thunderchopper would have suggested the claimed invention to those of ordinary skill in the art.”

Lee filed a request for reconsideration, to which the Board responded after five years.

the Thunderchopper Handbook was “analogous art” because it was “from the same field of endeavor” as the Lee invention, and that the field of video games was “reasonably pertinent” to the problem of adjusting display functions because the Thunderchopper Handbook showed video demonstrations of the “features” of the game. On the matter of motivation to combine the Nortrup and Thunderchopper references, the Board stated that “we maintain the position that we stated in our prior decision” and that the Examiner’s Answer provided “a well reasoned discussion of why there is sufficient motivation to combine the references.” The Board did not state the examiner’s reasoning, and review of the Examiner’s Answer reveals that the examiner merely stated that both the Nortrup function menu and the Thunderchopper demonstration mode are program features and that the Thunderchopper mode “is user-friendly” and it functions as a tutorial, and that it would have been obvious to combine them.

must set forth its findings and the grounds thereof, as supported by the agency record, and explain its application of the law to the found facts. The Court has often explained:

The Administrative Procedure Act, which governs the proceedings of administrative agencies and related judicial review, establishes a scheme of "reasoned decisionmaking." Not only must an agency's decreed result be within the scope of its lawful authority, but the process by which it reaches that result must be logical and rational.

tion. In other words, the Board must explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious." *In re Fritch*, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992) (the examiner can satisfy the burden of showing obviousness of the combination "only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references").

[2] With respect to Lee's application, neither the examiner nor the Board adequately supported the selection and combination of the Nortrup and Thunderchopper references to the reader obvious that which Lee described. The examiner's conclusory statements that "the demonstration mode is just a programmable feature which can be used in many different device[s] for providing automatic introduction by adding the proper programming software" and that "another motivation would be that the automatic demonstration mode is user friendly and it functions as a tutorial" do not adequately address the issue of motivation to combine. This factual question of motivation is material to patentability, and could not be resolved on subjective belief and unknown authority. It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher." *W.L. Gore v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983). Thus the Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion.

Deferential judicial review under the Administrative Procedure Act does not relieve the agency of its obligation to develop an evidentiary basis for its findings. To the contrary, the Administrative Procedure Act reinforces this obligation. See, e.g., *Motor Vehicle Manufacturers Ass'n v. State Farm Mutual Automobile Ins. Co.*, 463 U.S. 29, 43 (1983) ("the agency must examine the relevant data and articulate a satisfactory explanation for its action including a 'rational connection between the facts found and the choice made.'") (quoting *Burlington Truck Lines v. United*

the Board's general conclusions about what is "basic knowledge" or "common sense." "The Board's findings must extend to all material facts and must be documented on the record, lest the "haze of so-called expertise" acquire insulation from accountability." "Common knowledge and common sense," even if assumed to derive from the agency's expertise, do not substitute for authority when the law requires authority. See *Allenstown Mack*, 522 U.S. at 376 ("Because reasoned decisionmaking demands it, and because the systemic consequences of any other approach are unacceptable, the Board must be required to apply in fact the clearly understood legal standards that it enunciates in principle . . .").

The case on which the Board relies for its departure from precedent, *In re Bozek*, 416 F.2d 1385, 163 USPQ 545 (CCPA 1969), indeed mentions "common knowledge and common sense," the CCPA stating that the phrase was used by the Solicitor to support the Board's conclusion of obviousness based on evidence in the prior art. *Bozek* did not hold that common knowledge and common sense are a substitute for evidence, but only that they may be applied to analysis of the evidence. *Bozek* did not hold that objective analysis, proper authority, and reasoned findings can be omitted from Board decisions. Nor does *Bozek*, after thirty-two years of isolation, outweigh the dozens of rulings of the Federal Circuit and the Court of Customs and Patent Appeals that determination of patentability must be based on evidence. This court has remarked, in *Smiths Industries Medical Systems, Inc. v. Vital Signs, Inc.*, 183 F.3d 1347, 1356, 51 USPQ2d 1415, 1421 (Fed. Cir. 1999), that *Bozek*'s reference to common knowledge "does not in and of itself make it so" absent evidence of such knowledge.

[3] The determination of patentability on the ground of unobviousness is ultimately one of judgment. In furtherance of the judgmental process, the patent examination procedure serves both to find, and to place on the official record, that which has been considered with respect to patentability. The patent examiner and the Board are deemed to have experience in the field of the invention; however, this experience, insofar as applied to the determination of patentability, must be applied from the viewpoint of "the person having ordinary skill in the art to which said subject matter pertains," the words of section 103. In finding the

relevant facts, in assessing the significance of the prior art, and in making the ultimate determination of the issue of obviousness, the examiner and the Board are presumed to act from this viewpoint. Thus when they rely on what they assert to be general knowledge to negate patentability, that knowledge must be articulated and placed on the record. The failure to do so is not consistent with either effective administrative procedure or effective judicial review. The board cannot rely on conclusory statements when dealing with particular combinations of prior art and specific claims, but must set forth the rationale on which it relies.

Alternative Grounds

[4] At oral argument the PTO Solicitor proposed alternative grounds on which this court might affirm the Board's decision. However, as stated in *Burlington Truck Lines, Inc. v. United States*, 371 U.S. 156, 168 (1962), "courts may not accept appellate counsel's *post hoc* rationalization for agency action." Consideration by the appellate tribunal of new agency justifications deprives the aggrieved party of a fair opportunity to support its position; thus review of an administrative decision must be made on the grounds relied on by the agency. "If those grounds are inadequate or improper, the court is powerless to affirm the administrative action by substituting what it considers to be a more adequate or proper basis." *Securities & Exchange Comm'n v. Chenery Corp.*, 332 U.S. 194, 196 (1947). As reiterated in *Federal Election Comm'n v. Akins*, 524 U.S. 11, 25 (1998), "If a reviewing court agrees that the agency misinterpreted the law, it will set aside the agency's action and remand the case — even though the agency (like a new jury after a mistrial) might later, in the exercise of its lawful discretion, reach the same result for a different reason." Thus we decline to consider alternative grounds that might support the Board's decision.

Further Proceedings

Sound administrative procedure requires that the agency apply the law in accordance with statute and precedent. The agency tribunal must make findings of relevant facts, and present its reasoning in sufficient detail that the court may conduct meaningful review of the agency action. In *Radio-Television News Directors Ass'n v. FCC*, 184 F.3d 872 (D.C.

Cir. 1999) the court discussed the "fine line between agency reasoning that is 'so crippled as to be unlawful' and action that is potentially lawful but insufficiently or inappropriately explained," quoting from *Checkosky v. Securities & Exch. Comm'n*, 23 F.3d 452, 464 (D.C. Cir. 1994); the court explained that "[i]n the former circumstance, the court's practice is to vacate the agency's order, while in the latter the court frequently remands for further explanation (including discussion of the relevant factors and precedents) while withholding judgment on the lawfulness of the agency's proposed action." *Id.* at 888. In this case the Board's analysis of the Lee invention does not comport with either the legal requirements for determination of obviousness or with the requirements of the Administrative Procedure Act that the agency tribunal set forth the findings and explanations needed for "reasoned decisionmaking." Remand for these purposes is required. See *Overton Park*, 401 U.S. at 420-221 (remanding for further proceedings appropriate to the administrative process).

VACATED AND REMANDED

Barbour v. Head

U.S. District Court
Southern District of Texas
No. G-01-491

Decided December 21, 2001

COPYRIGHTS

[1] Non-copyrightable matter — Ideas and systems (§ 211.05)

Defendants are not entitled to summary judgment that plaintiffs' cooking recipes are uncopyrightable, even though 17 U.S.C. § 102(b) denies copyright protection to mere procedures or processes, since neither courts nor Register of Copyrights have declared that recipes are per se uncopyrightable, since defendants have not shown that plaintiffs' cookbook is copyrighted as factual compilation or collective work rather than literary work, and since even if book is not literary work, genuine issue of material fact exists as to whether plaintiffs' recipes, which contain more than mechanical listings of ingredients and cooking

instructions, represent mere unprotected facts or protectable expression.

JUDICIAL PRACTICE AND PROCEDURE

[2] Procedure — Limitations period; timeliness (§ 410.05)

Plaintiffs' claim for copyright infringement is not barred by three-year statute of limitations specified by 17 U.S.C. § 507(b), even though infringement claim was brought more than three years after infringing work was first published, since discovery rule and other equitable tolling doctrines apply to copyright claims, since plaintiffs' cause of action arguably did not accrue until they discovered defendants' book, less than one year before suit was brought, and since even if claim accrued on date of first publication, limitations period bars only remedy, not substantive right.

Action by Judy Barbour and Cookbook Resources LLC against James Head and Penfield Press Inc. for copyright infringement, and for unfair competition through misappropriation and conversion. On defendants' motion for summary judgment. Denied as to copyright claims; granted as to state law claims.

G.P. Hardy III, Houston, Texas, for plaintiffs.

Karen Bryant Tripp, Houston, for defendants.

Kent, J.

ORDER GRANTING IN PART DEFENDANT PENFIELD PRESS' MOTION TO DISMISS

This case involves a rustled cowboy cookbook. On August 13, 2001, Plaintiffs Judy Barbour ("Barbour") and Cookbook Resources, L.L.C. ("Cookbook Resources") filed causes of action for copyright infringement, unfair competition through misappropriation, and conversion, with which they're fixin' to brand Defendants James Head ("Head") and Penfield Press, Inc. ("Penfield Press"). On October 25, 2001, to bust out of the corral, Defendant Penfield Press filed a Motion to Dismiss pursuant to Fed.R.Civ.P. 12(b)(6). For the reasons articulated below, Defendant's Motion to Dismiss shall be

treated as a Motion for Summary Judgment and GRANTED IN PART.

I. FACTUAL SUMMARY

Plaintiff Barbour is the rootin'-tootin' author of *Cowboy Chow*,¹ a Texas-themed cookbook containin' larapin recipes, entertainin' ideas, histoootical information, and other cowboy fun. According to Plaintiffs, Barbour obtained a registered copyright on *Cowboy Chow* when it was first published in 1988. Following the book's initial commercial success, there being a lot of hungry cowpokes out there, Barbour entered into a publishing and manufacturing agreement with Cookbook Resources on February 24, 2001, whereby Cookbook Resources acquired Barbour's copyright on *Cowboy Chow*. Sometime prior to or during 1996, an internet magazine published by Defendant Head, called *Texas Online*, began publishing virtually verbatim recipes from *Cowboy Chow* without Barbour's knowledge or consent. In 1996, Defendant Penfield Press published a compilation cookbook by author Dianna Stevens ("Stevens") entitled *Licence to Cook Texas Style*² that similarly published virtually verbatim recipes from *Cowboy Chow* without Barbour's knowledge or permission. Many of these recipes were expressly credited to Jim Head at *Texas Online*.³ After discovering these copyright infringements in May of 2001, Barbour and Cookbook Resources filed this lawsuit, specifically bringing causes of

¹ It could have been named *Huw Now to Brown a Cow*....

² Which could have been called *And the Cow Jumped Over the Spoon*....

³ In her affidavit, Stevens declares that she found some recipes on the internet website, *Texas Online*, and then published them in *Licence to Cook Texas Style* with Head's express permission. Per Head's request, Stevens credited Jim Head and *Texas Online* for each recipe obtained from *Texas Online*. However, Stevens claims she never saw a copy of *Cowboy Chow* until the filing of this lawsuit. (Stevens Decl. ¶¶ 3, 5.)

The Court has previously enunciated its belief that the Internet is "one large catalyst for rumor, innuendo, and misinformation," in large part because it provides no way of verifying the authenticity of the information it presents. *St. Clair v. Johnny's Oyster & Shrimp, Inc.*, 76 F. Supp.2d 773, 774 (S.D. Tex. 1999) (Kent, J.). The instant lawsuit apply demonstrates that "[n]o one can put anything on the Internet. No web-site is monitored for accuracy and nothing contained therein is under oath or even subject to independent verification absent underlying documentation." *Id.* at 775. In short, information obtained from the Internet is "inherently untrustworthy." *Id.* at 774.

action for copyright infringement under the Copyright Act of 1976 ("Copyright Act"), 17 U.S.C. § 101 *et seq.*, and Texas state law claims for unfair competition through misappropriation and conversion.

In its Motion to Dismiss, Defendant Penfield Press seeks a dismissal of Plaintiffs' claims based on the following three grounds: (1) Plaintiffs' recipes are not copyrightable; (2) Plaintiffs' claims are barred by the applicable statutes of limitations; and (3) Plaintiffs' state law claims are preempted by federal law. Defendant also identifies approximately twenty recipes that it contends are identical, or similar, to those stated in *Cowboy Chow*.⁴ Each of these recipes shares the same or a similar title, listing of ingredients, and directions for preparation, as well as sometimes employing other miscellaneous identical language. Among the highlights from this templating list of "cow-mestibles" are "Armadillo Eggs," "Cattle Baron Cheese Dollars," "Gringo Gulch Grog," and the ever-chic "Frito Pic." In their Response, Plaintiffs refute Defendant's assertions that the alleged copied material is not copyrightable and that Plaintiffs' claims are time-barred, but concede that their state law claims properly sound in copyright and therefore are preempted by federal copyright law.

II. ANALYSIS

A. Proper Treatment of Defendant's Motion

Penfield Press characterizes its motion as a Motion to Dismiss for Failure to State a Claim Upon Which Relief Can be Granted pursuant to Fed.R.Civ.P. 12(b)(6). However, the Court finds that Defendant is actually seeking summary judgment relief under Fed.R.Civ.P. 56. In relevant part, Rule 12(b) stipulates: "If, on a motion asserting the defense numbered (6) to dismiss for failure of the pleading to state a claim upon which relief can be granted, matters outside the pleading are presented to and not excluded by the court, the motion shall be treated as one for summary judgment and disposed of as provided in Rule 56." Fed.R.Civ.P. 12(b). In the instant case, Defendant attached five exhibits to its Motion to Dismiss, including two affidavits, a copy of *Licence to Cook Texas Style*, and substantial portions of

⁴ In addition, no doubt, to being lip-smuckin' good!

were not material to Connell's contractual obligation to deliver milled rice by a date certain. The board assessed liquidated damages from the delivery date set in the contract, in the amount of \$289,549.30.

Discussion

[1] In order for a motion for summary judgment to be granted all of the facts material to the result must either be free of dispute or, if disputed facts are resolved in favor of the non-movant, the movant must nevertheless be entitled to a judgment as a matter of law. *United States v. Diebold*, 369 U.S. 654, 655, 82 S.Ct. 993, 994, 8 L.Ed.2d 176 (1962); *Balboa Insurance Co. v. United States*, 775 F.2d 1158, 1163 (Fed.Cir.1985).

[2] Connell argues that the government's changed pattern of ordering rice from other purveyors greatly overburdened the southern mills, and that this government-induced situation contributed to Connell's inability to deliver milled rice in a timely way. The affidavits of both Connell's chief executive officer and the executive vice president of the Rice Millers Association "essentially supported", according to the board, Connell's position. The board held: "Overall, we conclude that questions of fact exist as to whether there was an established practice that the Government would administer its export programs so as not to overburden industry milling capabilities, that Appellant reasonably relied on such practice, that the government violated such practice, and that such violation was the proximate cause of Appellant's untimely deliveries." The board held that these facts were not material to Connell's obligations, holding, in essence, that the obligation to make timely delivery was absolute.

The governing regulations provide relief from liquidated damages under certain conditions. *General Terms and Conditions for the Procurement of Agricultural Commodities or Services*, Agricultural Stabilization and Conservation Service, United States Department of Agriculture, July 1981, Revision No. 1 ("USDA-1"). Article 69(b)(7) of USDA-1 states:

(7) Contractor shall not be liable for liquidated damages for delays due to causes which would relieve the contractor from liability for excess costs as provided in paragraph (c) of Article 70.

Article 70(c) provides that the contractor shall not be liable "for any excess costs if the failure to perform the contract arises out of causes beyond the control and without the fault or negligence of Contractor". These causes, as defined in article 2(i), include "acts of Government in either its sovereign or contractual capacity", but "the failure to perform must be beyond the control and without the fault or negligence of the party to the contract seeking excuse from liability."

Applying these provisions of USDA-1 to Connell's position on the facts, summary judgment against Connell should not have been granted. For example, on the issue of delay related to events surrounding the ship *Atalanti*: factual questions requiring resolution include not only whether the Agricultural Stabilization and Conservation Service freight forwarder, Ms. Ryan, had authority to make the statement that if the ship was delayed the delivery of rice could be delayed, but also whether Connell acted "without fault or negligence" in relying on that statement. If these factual questions and inferences are resolved in Connell's favor, summary judgment against Connell can not stand. Further, the board remarked that Connell's reliance on Ms. Ryan's advice accounted for at most three days of delay, the Labor Day weekend; but the record shows no mitigation based on these three days.

Although the board stated that "whether the Government was the proximate cause of appellant's untimely delivery may well excuse an appellant's payment of liquidated damages, in whole or in part", the board denied Connell discovery to develop this defense. The board concluded that it was irrelevant whether the government contributed to the delay in delivery caused by unavailable milling time, holding that Connell could have compensated for any governmental action that affected performance of the contract. The board held that Con-

nell "assumed the risk of unavailable milling time", and that Connell's contract obligations were not conditioned thereon.

[3] Both the board, and the government in its brief, offer theories as to how Connell might have managed, at whatever cost, to obtain milled rice for timely delivery. These theories, in view of the USDA regulations, are relevant only to the question of whether Connell's failure to perform was "beyond [its] control and without [its] fault or negligence". If the government created the situation that caused or contributed to Connell's late delivery, it can not be held as a matter of law that Connell was required to exceed reasonable efforts in order to compensate for this unwarranted government action.

The government cites *Jennie-O Foods, Inc. v. United States*, 580 F.2d 400, 409-10 (Ct.Cl.1978), which held that "unanticipated economic hardship" did not excuse failure to perform where the contractor had not shown that "the product (healthy turkeys) was unavailable within the boundaries of a reasonable area." There was no issue in *Jennie-O* of governmental contribution to the failure to perform; nor was a theory of strict liability applied. The issues there raised, as here, are fact-dependent, and in *Jennie-O* were fully developed at trial.

[4] Connell must be enabled to develop the facts pertinent to its defense that the government, acting in its sovereign or contractual capacities, contributed to the delay; the extent of that contribution; and whether Connell was at fault or negligent; for these facts are material to the issues of liability, and the extent thereof. The determination must be made as to whether exculpation has been shown under the circumstances. Public policy and the national interest, as well as the principles of contract law, so require. As the Court explained in *United States v. Brooks-Calloway Co.*, 318 U.S. 120, 122, 63 S.Ct. 474, 476, 87 L.Ed. 653 (1943), the purpose of the standard proviso in government contracts that authorizes such relief is:

Thus contractors know they are not to be penalized for unexpected impediments to prompt performance, and, since their

bids can be based on foreseeable and probable, rather than possible hindrances, the Government secures the benefit of lower bids and an enlarged selection of bidders.

Although the government argues that Connell "failed to meet its burden" on summary judgment, the denial of discovery related to this defense contributed to this failure.

REVERSED AND REMANDED.



In re David H. FINE
No. 87-1319.

United States Court of Appeals,
Federal Circuit.

Jan. 26, 1988.

The Board of Patent Appeals and Interferences of the United States Patent and Trademark Office affirmed rejection of claims of application for patent for system for detecting and measuring minute quantities of nitrogen compounds, and applicant appealed. The Court of Appeals, Mayer, Circuit Judge, held that: (1) it would not have been obvious to substitute nitric oxide detector for sulfur dioxide detector in prior system, and (2) sulfur detection system did not teach use of claimed temperature range.

Reversed.

Edward S. Smith, Circuit Judge, dissented and filed opinion.

1. Patents \Rightarrow 1633

System for detecting and measuring minute quantities of nitrogen compounds was not obvious in light of prior art for separating, identifying, and monitoring sulfur compounds or method for measuring chemiluminescence of reaction between ni-

Cite as 837 F.2d 1071 (Fed. Cir. 1988)

tric oxide and ozone which required continuous flowing of gaseous mixture into reaction chamber; method for measuring sulfur deliberately sought to avoid nitrogen compounds, and claimed invention retained each nitrogen compound constituent of gaseous sample in chromatograph for individual time period. 35 U.S.C.A. § 103.

2. Patents 6,114,19, 114,21

Patent and Trademark Office has burden to establish prima facie case of obviousness, which it may satisfy only by showing some objective teaching in prior art, or that knowledge generally available to one of ordinary skill and art would lead that individual to combined relevant teachings of references. 35 U.S.C.A. § 103.

3. Patents 6,266(1)

Whether particular combination might be "obvious to try" is not legitimate test of patentability. 35 U.S.C.A. § 103.

4. Patents 6,16,5

Patent which described preferred temperature range for separating, identifying and quantitatively monitoring sulfur compounds could be distinguished from claimed method for detecting and measuring minute quantities of nitrogen compounds which limited temperature to prevent nitrogen from other sources, where purpose of temperature limitation in prior art was to avoid formation of unwanted sulfides.

Morris Relson, Darby & Darby, P.C., New York City, for appellant. With him on the brief was Beverly B. Goodwin.

Lee E. Barrett, Associate Sol., Office of the Solicitor, Arlington, Va., for appellee. With him on the brief were Joseph F. Nakamura, Sol. and Fred E. McKelvey, Deputy Sol.

Before FRIEDMAN, SMITH and MAYER, Circuit Judges.

OPINION

MAYER, Circuit Judge.

David H. Fine appeals from a decision of the Board of Patent Appeals and Interfer-

ences of the United States Patent and Trademark Office (Board) affirming the rejection of certain claims of his application, Serial No. 512,374, and concluding that his invention would have been obvious to one of ordinary skill in the art and was therefore unpatentable under 35 U.S.C. § 103. We reverse.

BACKGROUND

A. The Invention.

The invention claimed is a system for detecting and measuring minute quantities of nitrogen compounds. According to Fine, the system has the ability to detect the presence of nitrogen compounds in quantities as minute as one part in one billion, and is an effective means to detect drugs and explosives, which emanate nitrogen compound vapors even when they are concealed in luggage and closed containers.

The claimed invention has three major components: (1) a gas chromatograph which separates a gaseous sample into its constituent parts; (2) a converter which converts the nitrogen compound effluent output of the chromatograph into nitric oxide in a hot, oxygen-rich environment; and (3) a detector for measuring the level of nitric oxide. The claimed invention's sensitivity is achieved by combining nitric oxide with ozone to produce nitrogen dioxide which concurrently causes a detectable luminescence. The luminescence, which is measured by a visual detector, shows the level of nitric oxide which in turn is a measure of nitrogen compounds found in the sample.

The appealed claims were rejected by the Patent and Trademark Office (PTO) under 35 U.S.C. § 103. Claims 60, 63, 77 and 80 were rejected as unpatentable over Eads, Patent No. 3,650,696 (Eads) in view of Warnick, et al., Patent No. 3,746,513 (Warnick). Claims 62, 68, 69, 79, 85 and 86 were rejected as unpatentable over Eads and Warnick in view of Glass, et al., Patent No. 3,207,585 (Glass).

B. The Prior Art.

1. Eads Patent.

Eads discloses a method for separating, identifying and quantitatively monitoring

sulfur compounds. The Eads system is used primarily in "air pollution control work in the scientific characterization of odors from sulfur compounds."

The problem addressed by Eads is the tendency of sulfur compounds "to adhere to or react with the surface materials of the sampling and analytical equipment, and/or react with the liquid or gaseous materials in the equipment." Because of this, the accuracy of measurement is impaired. To solve the problem, the Eads system collects an air sample containing sulfur compounds in a sulfur-free methanol solution. The liquid is inserted into a gas chromatograph which separates the various sulfur compounds. The compounds are next sent through a pyrolysis furnace where they are oxidized to form sulfur dioxide. Finally, the sulfur dioxide passes through a measuring device called a micro-coulometer which uses titration cells to calculate the concentration of sulfur compounds in the sample.

2. Warnick Patent.

Warnick is directed to a means for detecting the quantity of pollutants in the atmosphere. By measuring the chemiluminescence of the reaction between nitric oxide and ozone, the Warnick device can detect the concentration of nitric oxide in a sample gaseous mixture.

Warnick calls for "continuously flowing" a sample gaseous mixture and a reactant containing ozone into a reaction chamber. The chemiluminescence from the resulting reaction is transmitted through a light-transmitting element to produce continuous readouts of the total amount of nitric oxide present in the sample.

3. Glass Patent.

The invention disclosed in Glass is a device for "completely burning a measured amount of a substance and analyzing the combustion products." A fixed amount of a liquid petroleum sample and oxygen are supplied to a flame. The flame is then spark-ignited, causing the sample to burn. The resulting combustion products are then collected and measured, and from this mea-

surement the hydrogen concentration in the sample is computed.

C. The Rejection.

The Examiner rejected claims 60, 63, 77 and 80 because "substitution of the [nitric oxide] detector of Warnick for the sulfur detector of Eads would be an obvious consideration if interested in nitrogen compounds, and would yield the claimed invention." He further asserted that "Eads teaches the [claimed] combination of chromatograph, combustion, and detection, in that order.... Substitution of detectors to measure any component of interest is well within the skill of the art." In rejecting claims 62, 68, 69, 79, 85 and 86, the Examiner said, "Glass et al. teach a flame conversion means followed by a detector, and substitution of the flame conversion means of Glass et al. for the furnace of Eads would be an obvious equivalent and would yield the claimed invention." The Board affirmed the Examiner's rejection.

DISCUSSION

A. Standard of Review.

Obviousness under 35 U.S.C. § 103 is "a legal conclusion based on factual evidence." *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1535, 218 USPQ 871, 876 (Fed.Cir.1983) (quoting *Stevenson v. Int'l Trade Comm'n*, 612 F.2d 546, 549, 204 USPQ 276, 279 (CCPA 1979)). Therefore, an obviousness determination is not reviewed under the clearly erroneous standard applicable to fact findings, *Raytheon Co. v. Roper Corp.*, 724 F.2d 951, 956, 220 USPQ 592, 596 (Fed.Cir.1983); it is "reviewed for correctness or error as a matter of law." *In re De Blauwe*, 736 F.2d 699, 703, 222 USPQ 191, 195 (Fed.Cir.1984).

To reach a proper conclusion under § 103, the decisionmaker must step backward in time and into the shoes worn by [a person having ordinary skill in the art] when the invention was unknown and before it was made. In light of all the evidence, the decisionmaker must then determine whether ... the claimed invention as a whole would have been

obvious at that time to that person. 35 U.S.C. § 103. The answer to that question partakes more of the nature of law than of fact, for it is an ultimate conclusion based on a foundation formed of all the probative facts.

Panduit Corp. v. Dennison Mfg. Co., 810 F.2d 1561, 1566, 1 USPQ2d 1593, 1595-96 (Fed.Cir.1987).

B. Prima Facie Obviousness.

Fine says the PTO has not established a *prima facie* case of obviousness. He contends the references applied by the Board and Examiner were improperly combined, using hindsight reconstruction, without evidence to support the combination and in the face of contrary teachings in the prior art. He argues that the appealed claims were rejected because the PTO thought it would have been "obvious to try" the claimed invention, an unacceptable basis for rejection.

[1, 2] We agree. The PTO has the burden under section 103 to establish a *prima facie* case of obviousness. See *In re Piacsek*, 745 F.2d 1468, 1471-72, 223 USPQ 785, 787-88 (Fed.Cir.1984). It can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. *In re Lafu*, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed.Cir.1984); see also *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 297 n. 24, 227 USPQ 657, 667 n. 24 (Fed.Cir.1985); *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir.1984). This it has not done. The Board points to nothing in the cited references, either alone or in combination, suggesting or teaching Fine's invention.

The primary basis for the Board's affirmation of the Examiner's rejection was that it would have been obvious to substitute the Warnick nitric oxide detector for the Eads sulfur dioxide detector in the Eads system. The Board reiterated the Examiner's bald assertion that "substitution of one type of detector for another in the system of Eads

would have been within the skill of the art," but neither of them offered any support for or explanation of this conclusion.

Eads is limited to the analysis of sulfur compounds. The particular problem addressed there is the difficulty of obtaining precise measurements of sulfur compounds because of the tendency of sulfur dioxide to adhere to or react with the sampling analytic equipment or the liquid or gaseous materials in the equipment. It solves this problem by suggesting that the gaseous sample containing sulfur compounds be absorbed into sulfur-free methanol and then inserted into a gas chromatograph to separate the sulfur compounds.

There is no suggestion in Eads, which focuses on the unique difficulties inherent in the measurement of sulfur, to use that arrangement to detect nitrogen compounds. In fact, Eads says that the presence of nitrogen is undesirable because the concentration of the titration cell components in the sulfur detector is adversely affected by substantial amounts of nitrogen compounds in the sample. So, instead of suggesting that the system be used to detect nitrogen compounds, Eads deliberately seeks to avoid them; it warns against rather than teaches Fine's invention. See *W.L. Gore & Assoc. v. Garlock, Inc.*, 721 F.2d 1540, 1550, 220 USPQ 303, 311 (Fed.Cir. 1983) (error to find obviousness where references "diverge from and teach away from the invention at hand"). In the face of this, one skilled in the art would not be expected to combine a nitrogen-related detector with the Eads system. Accordingly, there is no suggestion to combine Eads and Warnick.

Likewise, the teachings of Warnick are inconsistent with the claimed invention, to some extent. The Warnick claims are directed to a gas stream from engine exhaust "continuously flowing from engine exhaustures into the reaction chamber" to obtain "continuous readouts" of the amount of nitric oxide in the sample. In other words, it contemplates measuring the total amount of nitric oxide in a continuously flowing gaseous mixture of unseparated nitrogen constituents. By contrast, in Fine each

nitrogen compound constituent of the gas-sample is retained in the chromatograph for an individual time period so that each exits in discrete, time-separated pulses." By this process, each constituent may be both identified by its position in time sequence, and measured. The claimed system, therefore, diverges from Warnick and teaches advantages not appreciated or contemplated by it.

[3] Because neither Warnick nor Eads, alone or in combination, suggests the claimed invention, the Board erred in affirming the Examiner's conclusion that it would have been obvious to substitute the Warnick nitric oxide detector for the Eads sulfur dioxide detector in the Eads system. *ACS Hosp. Sys.*, 732 F.2d at 1575-77, 221 USPQ at 931-33. The Eads and Warnick references disclose, at most, that one skilled in the art might find it obvious to try the claimed invention. But whether a particular combination might be "obvious to try" is not a legitimate test of patentability. *In re Geiger*, 815 F.2d 686, 688, 2 USPQ2d 1276, 1278 (Fed.Cir.1987); *In re Goodwin*, 576 F.2d 375, 377, 198 USPQ 1, 3 (CCPA 1978).

Obviousness is tested by "what the combined teachings of the references would have suggested to those of ordinary skill in the art." *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). But it "cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination." *ACS Hosp. Sys.*, 732 F.2d at 1577, 221 USPQ at 933. And "teachings of references can be combined only if there is some suggestion or incentive to do so." *Id.* Here, the prior art contains none.

Instead, the Examiner relies on hindsight in reaching his obviousness determination. But this court has said, "To imbue one of ordinary skill in the art with knowledge of

* The Solicitor argues that the contents of Attachment C of Fine's brief were not before the Board and may not properly be considered here. However, we need not rely on Attachment C. It is merely illustrative of the qualitative separation of nitrogen compounds which occurs in Fine's system. The fact that the vari-

the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher." *W.L. Gore*, 721 F.2d at 1553, 220 USPQ at 812-13. It is essential that "the decisionmaker forget what he or she has been taught at trial about the claimed invention and cast the mind back to the time the invention was made ... to occupy the mind of one skilled in the art who is presented only with the references, and who is normally guided by the then-accepted wisdom in the art." *Id.* One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.

C. Advantage Not Appreciated by the Prior Art.

[4] The Board erred not only in improperly combining the Eads and Warnick references but also in failing to appreciate that the appealed claims can be distinguished over that combination. A material limitation of the claimed system is that the conversion to nitric oxide occur in the range of 600°C to 1700°C. The purpose of this limitation is to prevent nitrogen from other sources, such as the air, from being converted to nitric oxide and thereby distorting the measurement of nitric oxide derived from the nitrogen compounds of the sample.

The claimed nitric oxide conversion temperature is not disclosed in Warnick. Although Eads describes a preferred temperature of 675°C to 725°C, the purpose of this range is different from that of Fine. Eads requires the 675°C to 725°C range because it affords a temperature low enough to avoid formation of unwanted sulfur trioxide, yet high enough to avoid formation of unwanted sulfides. Fine's temperature

ous constituents exit at discrete intervals is shown by the specification which was before the Board and which may appropriately be considered on appeal. See, e.g., *Astra-Sjucos A.B. v. United States Int'l Trade Comm'n*, 629 F.2d 682, 686, 207 USPQ 1, 5 (CCPA 1980) (claims must be construed in light of specification).

range, in contrast, does not seek to avoid the formation of sulfur compounds or even nitrogen compounds. It enables the system to break down the nitrogen compounds of the sample while avoiding the destruction of background nitrogen gas. There is a partial overlap, of course, but this is mere happenstance. Because the purposes of the two temperature ranges are entirely unrelated, Eads does not teach use of the claimed range. See *In re Geiger*, 815 F.2d at 688, 2 USPQ2d at 1278. The Board erred by concluding otherwise.

D. Unexpected Results.

Because we reverse for failure to establish a *prima facie* case of obviousness, we need not reach Fine's contention that the Board failed to accord proper weight to the objective evidence of unexpected superior results. *Id.*

E. The "Flame" Claims.

Claims 62, 68, 69, 79, 85 and 86 relate to the oxygen-rich flame conversion means of the claimed invention. These "flame" claims depend from either apparatus claim 60 or method claim 77. Dependent claims are nonobvious under section 103 if the independent claims from which they depend are nonobvious. *Hartness Int'l, Inc. v. Simplimatic Eng'g Co.*, 819 F.2d 1100, 1108, 2 USPQ2d 1826, 1831 (Fed.Cir.1987); *In re Abelle*, 684 F.2d 902, 910, 214 USPQ 682, 689 (CCPA 1982); see also *In re Sernaker*, 702 F.2d 989, 991, 217 USPQ 1, 3 (Fed.Cir.1983). In view of our conclusion that claims 60 and 77 are nonobvious, the dependent "flame" claims are also patentable.

CONCLUSION

The Board's decision affirming the Examiner's rejection of claims 60, 62, 63, 68, 69, 77, 79, 80, 85 and 86 of Fine's application as unpatentable over the prior art under 35 U.S.C. § 103 is REVERSED.

EDWARD S. SMITH, Circuit Judge, dissenting.

I respectfully dissent. I am of the firm belief that the prior art references, relied upon by the PTO to establish its *prima facie* case of obviousness, in combination teach and suggest Fine's invention to one skilled in the art. Also, I firmly believe that Fine failed to rebut the PTO's *prima facie* case. On this basis, I would affirm the board's determination sustaining the examiner's rejection, pursuant to 35 U.S.C. § 103, of Fine's claims on appeal before this court.



PETROCHEM SERVICES, INC., Appellant,

v.

The UNITED STATES, Appellee.
No. 87-1382.

United States Court of Appeals,
Federal Circuit.

Decided Jan. 26, 1988.

Government contractor appealed decision of the Armed Services Board of Contract Appeals denying contractor's claim for equitable adjustment of contract to remove oil spilled on naval base. The Court of Appeals, Nichols, Senior Circuit Judge, held that Government's duty to disclose superior knowledge was not legally discharged by Navy supervisor's oral representations, unless contractor's representative heard and understood representations. Vacated and remanded.

1. United States ¶70(30)

Disclosure of superior knowledge doctrine applies in situations where contractor undertakes to perform without vital knowledge of fact that affects performance costs.

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Cite as 837 F.2d 1076 (Fed. Cir. 1988)

or duration, Government was aware contractor had no knowledge of and had no reason to obtain such information, any contract specifications supplied misled contractor, or did not put it on notice to inquire, and Government failed to provide relevant information.

2. United States ¶70(30)

Once Government advised contractor's representative that 21,000 gallons of oil had spilled, and number of gallons estimated by representative varied tremendously from Government's assessment, burden shifted to contractor to inquire further in order to verify crucial contract specification.

3. United States ¶70(30)

There is no express or implied rule that Government must provide its contractors information in writing in order to discharge its duty to disclose superior knowledge.

4. United States ¶70(30)

If Government is not held liable for failing to warn contractors of specific conditions noticeable in site inspection, then Government should not be held liable for making effort to disclose superior knowledge, albeit, not in best fashion.

5. United States ¶70(30)

Where oral communications were made to contractor, Government may not satisfy its duty to disclose superior knowledge unless it shows that communication was not only made, but also heard, and understood, actually or apparently; Government may satisfy its burden by showing, either through conversations held between contractor and government agent or other such evidence, that it reasonably believed contractor was aware of communication and understood its import.

6. United States ¶70(30)

Government's duty to disclose superior knowledge was not legally discharged by Navy supervisor's oral representations to government contractor's representative, at time of on-site inspection, that 21,000 gallons of oil had spilled, unless representative heard and understood representation.

837 F.2d-25

PETROCHEM SERVICES, INC. v. U.S.

Cite as 837 F.2d 1076 (Fed. Cir. 1988)

Ronald Van Stockum, Jr., Louisville, Ky., submitted for appellant.

Jeanne A. Anderson, Commercial Litigation Branch, Dept. of Justice, Washington, D.C., submitted for appellee. With her on the brief were Richard K. Willard, Asst. Atty. Gen., David M. Cohen, Director and Thomas W. Petersen, Asst. Director. Also on the brief was Ken Homick, Asst. Counsel, Dept. of the Navy, of counsel.

Before ARCHER, Circuit Judge, NICHOLS, Senior Circuit Judge, and MAYER, Circuit Judge.

NICHOLS, Senior Circuit Judge.

Petrochem Services, Inc. appeals the decision of the Armed Services Board of Contract Appeals [ASBCA or board]. ASBCA No. 33105, 87-1 BCA (CCH) ¶ 19,597 (1987), holding that the government discharged its duty to disclose superior knowledge through oral representations made to appellant at the time of on-site inspection. We vacate the ASBCA's judgment denying Petrochem's appeal and remand.

Issues

The issues raised by the parties are two-fold. First, was the government's duty to disclose superior knowledge legally discharged by the government's oral representations to Petrochem? Second, was the ASBCA's decision arbitrary, capricious, so grossly erroneous as to imply bad faith, or not supported by substantial evidence so as to require reversal and remand?

Background

On January 29, 1982, oil spilled from a storage tank being filled at the Great Lakes, Illinois Naval Base. The tank: is a part of the facility's steam generation capability and provides back-up fuel The tank is constructed of steel and is approximately 60 to 70 feet in diameter, 40 feet high and contains perhaps as much as a half million gallons of fuel oil. The tank sits in the middle of a rectangular containment area approximately 80 x 100 feet in size. The floor

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